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09/629,492	07/31/2000	Juei Chang	P3925	4269

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT PAPER NUMBER

2178

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/629,492

Applicant(s)

CHANG ET AL.

Examiner

Joshua D. Campbell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Request for Continued Examination filed on 10/06/2005.
2. Claims 1-2, 4-7, 9-11, and 13-20 are pending in this case. Claims 1 and 10 are independent claims. Claims 1 and 10 have been amended.

### ***Claim Rejections - 35 USC § 112***

3. Claims 1, 2, 4-7, and 9 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As stated in of claim 1, "...fully automating the functionality of a manual navigation system," the invention must be capable of performing all of the functions of a manual navigation system in a fully automated manner. However, the specification does not clearly state what all of the functions of a manual navigation system are, nor does it state how the invention supports each and every function of a manual navigation system in a fully automated manner, for instance on page 56, lines 6-12 of the specification it is stated that auto-registration may be accomplished by two orders, both of which require the user making a selection, which would be considered part of the navigation process. Thus, rendering this claim indefinite due to the lack of enablement. The claim will be interpreted as automating the functionality of a navigation system in such a way that allows the system to perform set of actions based on the examiner's

interpretation of a navigation system, in this case the examiner contends that Burson et al. teaches the automation of a set of actions. This interpretation of the language does not overcome the rejection under 35 U.S.C. 112; rather it sets a standard for examination of the claims in order to further prosecution.

4. Claims 1-2, 4-7, 9-11, and 13-20 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As stated in claims 1, "...allows the system to perform normal user navigation and registration actions automatically," the invention must be capable of performing all of the function required to perform "normal" navigation and registration. However, the specification does not clearly state what all of the "normal" functions of a manual navigation and registration system are. This problem also arises in the final limitation of claim 10. In order to further prosecution, the claim will be interpreted as automating the functionality of a navigation system in such a way that allows the system to perform set of actions based on the examiner's interpretation of a navigation system, in this case the examiner contends that Burson et al. teaches the automation of a set of actions. This interpretation of the language does not overcome the rejection under 35 U.S.C. 112; rather it sets a standard for examination of the claims in order to further prosecution. In order to overcome the rejection the specific functions performed must be contained within the claim. Another possible correction would be to replace the word "normal" with the phrase "a set of," however using that phrase would not overcome the

rejection in place based on Burson et al. unless the actions of the set were defined in the claim language to be functions that were not taught by Burson et al. **Proper Correction is Required.**

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-2, 4-7, 9-11, and 13-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Burson et al. (US Patent Number 6,405,245, filed on October 28, 1998).

**Regarding independent claim 1**, Burson et al. discloses a method which includes the use of a browser application to navigate on a network (Internet) (column 4, lines 36-65 of Burson et al.). Burson et al. discloses a method in which processing components (functions) of a PI engine are used to perform tasks automatically (column 4, line 66-column 5, line 21 of Burson et al.). Burson et al. discloses a method in which the processing components are integrated into browser functionality (column 4, lines 36-65 of Burson et al.). The PI that is obtained using the PI engine contains additional instructions on how to execute transactions (column 4, line 66-column 5, line 21 of Burson et al.). Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions, which include navigation and registration transactions, invisible to the user (column 7, lines 30-67). The PI

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engine generates a simulated web client (browser instance) to perform tasks which are monitored, and when the task is completed the data is returned to the user interface of the browser application at which point the simulated web client is terminated and control is returned to the user interface (column 7, lines 30-67 of Burson et al.). Burson et al. also discloses a method in which additional procedures necessary to complete a transaction may be contained within the PI store (column 4, line 66-column 5, line 21 of Burson et al.). Burson et al. does not disclose the use of an API for integration purposes. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an API to allow an application such as a browser to operate in conjunction with separate processing components (i.e. Java applets – column 8, lines 13-45 of Burson et al.) because APIs are commonly used to provide communication between applets in Java virtual machine.

**Regarding dependent claim 2**, Burson et al. discloses a method which includes the use of a browser application to navigate on the Internet (column 4, lines 36-65 of Burson et al.).

**Regarding dependent claim 4**, Burson et al. discloses a method in which the PI engine (control application) is made of processing components (programs) to execute tasks (column 6, lines 24-65 of Burson et al.). It is inherent that a program operated by a computer is in the form of machine-readable instructions.

**Regarding dependent claims 5 and 6**, Burson et al. discloses a method in which a user can specify what navigation sequences to perform (one or more) (column 4, line 66-column 5, line 21 of Burson et al.)

**Regarding dependent claims 7 and 9,** Burson et al. discloses a method in which the PI engine can execute on a single processor and multiple processors (column 6, lines 24-65 of Burson et al.).

**Regarding independent claim 10,** Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions, which include navigation and registration transactions, invisible to the user (column 7, lines 30-67). The PI engine generates a simulated web client (browser instance) to perform tasks which are monitored, and when the task is completed the data is returned to the user interface of the browser application at which point the simulated web client is terminated and control is returned to the user interface (column 7, lines 30-67 of Burson et al.). Burson et al. discloses a method in which the PI engine (control application) is made of processing components (programs) to execute tasks (column 6, lines 24-65 of Burson et al.). Burson et al. does not disclose the use machine-readable instructions to operate the control application. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that a program, such as a control application (PI engine), operated by a computer would be in the form of machine-readable instructions.

**Regarding dependent claim 11,** Burson et al. discloses a method, which includes the use of a browser application to navigate on the Internet (column 4, lines 36-65 of Burson et al.).

**Regarding dependent claims 13-16,** Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions

invisible to the user (column 7, lines 30-67). The PI engine generates a simulated web client (browser instance) to perform tasks which are monitored, and when the task is completed the data is returned to the user interface of the browser application at which point the simulated web client is terminated and control is returned to the user interface (column 7, lines 30-67 of Burson et al.).

**Regarding dependent claims 17 and 18,** Burson et al. discloses that automated browser functions include emulating all user input actions during navigation (column 10, lines 4-43 of Burson et al.) Burson et al. does not disclose the use of an API for integration purposes with the different functions. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an API to allow an application such as a browser to operate in conjunction with separate functions (i.e. Java applets – column 8, lines 13-45 of Burson et al.) because APIs are commonly used to provide communication between applets in Java virtual machine.

**Regarding dependent claim 19,** Burson et al. discloses a method in which the functional programs intercept the dialog necessary to navigate (i.e. cookie information) (column 8, lines 4-65 of Burson et al.).

7. Claim 20 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Burson et al. (US Patent Number 6,405,245, filed on October 28, 1998) as applied to claim 18 above, and further in view of Thompson et al. (US Patent Number 6,571,253, filed on April 28, 2000).



**Regarding dependent claim 20**, Burson et al. does not disclose displaying the data structure in a tree format as part of the search function. However, Thompson et al. discloses a method in which in order to perform a search an HTML document is first broken down into a DOM tree which defines the hierarchal structure of the display of the document (column 2, lines 1-65 of Thompson et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of searching of Thompson et al. with the application of searching of Burson et al. because it would have increased the expressive power for locating the data item of interest.

### ***Response to Arguments***

8. Applicant's arguments filed 10/6/2005 have been fully considered but they are not persuasive.

Regarding the arguments on pages 6-8, in reference to the 112 rejection regarding claims 1-2, 4-7, 9-11, and 13-20, the examiner has reapplied a 112 rejection and believes the rejection to be proper and warranted. The enablement requirement states that a claim is not enabled if the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim states that the invention must be capable of performing "normal" functions of a manual navigation system. However, the specification does not clearly state what the normal functions of a manual navigation system are, this being important because two

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different people of ordinary skill in the art at the time the invention was made might have a very different interpretation of what "normal" functionality of a manual navigation system is. In addition to this, the specification does not state how the invention supports each "fully automating" every function of a manual navigation system, and one of ordinary skill in the art cannot be expected to create the invention to interact with every possible function of a manual navigation system without performing undo experimentation, without teaching these interactions in the specification. Additionally, the interpretation of "normal" functions of a manual navigation system will undoubtedly change as manual navigation system technology advances, the applicants will not be granted inventive immunity for these functions, thus it is imperative that the specific functions and how the functions are interacted with must be disclosed in the specification in order to enable the claimed invention. Thus, claims 1-2, 4-7, 9-11, and 13-20 suffer from lack of enablement for the above reasons and the rejection of the claims under 35 U.S.C. 112, first paragraph will be applied to the amended claims.

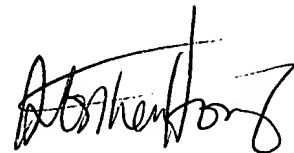
Regarding the arguments on pages 8-9, in reference to the rejection of claims 1-2, 4-7, 9-11, and 13-20 specifically regarding the phrases "fully automating the functionality of a manual navigation system..." and "normal user navigation and registration actions," the examiner believes that based on the interpretation of the claims as warranted by the lack of enablement Burson does in fact teach the claim, thus the rejection is maintained based on the stated interpretation. In order to overcome this rejection the 35 U.S.C. 112 rejection must first be overcome.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**STEPHEN HONG  
SUPERVISORY PATENT EXAMINER**

JDC  
December 15, 2005